

Atty Dkt. No.: 10010382-1
Appl. No.: 10/066,157

REMARKS

In view of the following remarks, the Examiner is requested to allow Claims 15-21, 27, 29, and 30, the only claims pending and under examination in this application.

Claims 1-14, 22-26, 28, 31 and 32 have been cancelled. Claim 15 has been amended to recite that the calibration member has a uniform fluorescent layer. Support for this amendment is found in the specification on page 12 lines 15-19. Claim 17 has been amended to recite that it depends from a method claim. Support for new claims 33-38 and 40-46 can be found in the specification on page 12 lines 9-26. Support for new claim 39 can be found in original claim 15 and in the specification in the Summary and from page 14 line 29 to page 16 line 15. Support for new claims 46 and 48 can be found in original claims 29 and 30.

As no new matter is added by way of these amendments, entry thereof is respectfully requested.

Election/Restriction

The Applicant affirms the previous election to prosecute the invention of Group II, claims 15-21 and 27-30, with traverse.

Objections to the Claims

Claims 28-30 are objected to as being in improper form because multiple dependent claims should refer to claims in the alternative only.

In response, the Applicant has canceled multiple-dependent Claim 28. However, original Claims 29 and 30 are not multiple dependent claims as suggested by the Examiner (each depend only from Claim 27), and thus have been kept in their original form. Because improper multiple dependent Claim 28 has been canceled, this objection may be withdrawn.

Claim Rejections - 35 USC § 102

The Office Action states that Claims 15-21 and 27 are rejected under 35 USC § 102(b) as being anticipated by WO 99/47964.

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With regard to a prior art document anticipating a claim, MPEP § 2131 states:

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Claim 15 is drawn to methods of using a chemical array reader which includes the steps of positioning a calibration member having a uniform fluorescent layer at the reading position of the array reader (i.e., the position at which a chemical array is read), illuminating the calibration member from the light system, detecting the emitted light using the detection system to generate a resulting calibration signal, adjusting a position of the calibration member relative to the focal plane, determining the position of the focal plane from the light detected at various adjustments, and calibrating a sensitivity of the detection system from the detection system signals generated from the calibration member. In short, the claimed method employs a calibration member having a uniform fluorescent layer to calibrate a chemical array reader for subsequent scanning of a chemical array. The calibration member of the subject application is described in detail in the specification, including on page 12 lines 15 to 26.

The Examiner states that WO 99/47964 (Overbeck) anticipates the claimed invention. In making this rejection, the Examiner asserts that Overbeck discloses a method of using a DNA array scanner as is claimed in the subject application, including auto-focus and fluorescence detection capability. The Examiner specifically asserts that Overbeck teaches "[p]rescan of the microscope slide" which "enables determination of the height of best focus of the microscope slide at a chosen grid of points on the microscope slide". However, the Applicant submits that Overbeck does not teach or disclose a method of using a chemical array reader that includes using a calibration member having a uniform fluorescent layer to adjust the scan settings of the chemical array reader as is claimed in the subject application.

Therefore, because Overbeck (WO 99/47964) fails to teach or disclose each and every element of Claim 15, and all of the remaining rejected claims depend

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therefrom, the Applicant respectfully requests withdrawal of the rejection of claims 15-21 and 27 under 35 USC § 102(b).

Finally, the Applicant has added new claims 39 to 48, in which an independent calibration member is used to calibrate the chemical array reader prior to scanning a chemical array. The Applicant submits that Overbeck does not teach or disclose using a calibration member that is independent of the array to be scanned, as is claimed in new claims 39-48. At best, as asserted by the Examiner, Overbeck discloses prescanning the array itself to auto-focus the microscope. As such, new claims 39-48 are also patentable over the cited references.

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CONCLUSION

In view of the amendments and remarks above, the Applicant respectfully submits that all of the claims are in condition for allowance, which action is requested. If the Examiner finds that a telephone conference would expedite the prosecution of this application, please telephone Dianne Rees at (650) 485-5999. The Commissioner is hereby authorized to charge any fees under 37 C.F.R. §§ 1.16 and 1.17 which may be required by this paper, or to credit any overpayment, to Deposit Account No. 50-1078, order number 10010382-1.

Respectfully submitted,

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